

VON MALTITZ, DERENBERG, KUNIN, JANSSEN & GIORDANO

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September 11, 2012

United States Patent and
Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

In the matter of the Opposition by BEIERSDORF AG
against Application Serial Nos. 85/495,821 and 85/495,815
filed by Johnson & Johnson, and published in the Official
Gazette on May 22, 2012, we enclose the following:

- (1) Original of the opposition;
- (2) Our check in the amount of \$600.00 in payment
of the statutory fee; and
- (3) Acknowledgment postcard.

Please stamp and return the postcard as your
acknowledgment of safe receipt.

Also, please charge our Patent and Trademark Office
Deposit Account No. 22-0560 for any additional fees that may
be required.

All correspondence or communications concerning
this application should be directed to the undersigned.

Very truly yours,



V. T. Giordano

VTG/jf
Enc.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial Nos. 85/495,821 and
85/495,815

Both Published in the OFFICIAL GAZETTE on May 22, 2012

- - - - -X

BEIERSDORF AG,	:	
Opposer,	:	
v.	:	Consolidated Opposition No.
		09/14/2012 SWILSON1 00000004 85495821
JOHNSON & JOHNSON,	:	01 FC:6402 300.00 OP
Applicant.	:	
		09/14/2012 SWILSON1 00000005 85495815
		-X 01 FC:6402 300.00 OP

NOTICE OF CONSOLIDATED OPPOSITION

Beiersdorf AG, a corporation organized and existing under the laws of Germany, located and doing business at Unnastrasse 48, Hamburg 20253, Germany, believes it will be damaged by registration of the marks shown in applications Serial Nos. 85/495,821 and 85/495,815 ("Opposed Applications"), filed by Johnson & Johnson ("Applicant"), and hereby opposes said applications, the time for filing such Notice of Opposition against each application having been duly extended until September 19, 2012.

Opposer brings this consolidated opposition, pursuant to Section 13(a) of the Trademark Act of 1946, as amended, based on likelihood of confusion (Section 2(d)), dilution (Section 43(c)), and Applicant's lack of a bona fide intent, as of the Opposed Applications' filing date, to use the marks shown in therein in the United States or in commerce with the United States on all the goods in the Opposed Applications (Section 1(b)). The grounds of this consolidated opposition are as follows:

1. (a) On December 15, 2011, Applicant filed application SN 85/495,821 under Section 1(b) of the Lanham Act to register the mark NUAVA for

"Human pharmaceuticals for the treatment of anti-viral diseases, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases, pain, dermatologic disorders, gastro-intestinal diseases, infectious-related diseases, metabolic diseases, oncologic diseases, ophthalmic diseases and respiratory diseases, muscle dystonias, wrinkles and smooth muscle disorders" in Class 5 ("Applicant's Goods").

(b) On December 15, 2011, Applicant also filed application SN 85/495,815 under Section 1(b) of the Lanham Act to register the mark NUVEE for Applicant's Goods.

(c) Upon information and belief, neither of the marks shown in the Opposed Applications ("the Opposed Marks") was used in the United States or in commerce with the United States by

Applicant for any of Applicant's Goods on or before December 15, 2011.

(d) Upon information and belief, neither of the Opposed Marks has been used in the United States or in commerce with the United States by Applicant for any of Applicant's Goods after December 15, 2011.

2. Opposer is, and has long been, a leading manufacturer and marketer of skin care products. Since long prior to the filing date of the Opposed Applications, Opposer and its predecessors in business (hereinafter, collectively, "Opposer") have owned the distinctive trademark NIVEA. Opposer's NIVEA trademark has, for many decades, been extensively used in connection with the national marketing and sale in the United States of Opposer's skin creams, lotions and other skin care products. Opposer's NIVEA skin care products have been marketed and sold in the United States through Opposer's indirect, wholly-owned subsidiary, Beiersdorf, Inc.

3. Opposer's NIVEA trademark is one of the oldest and best-known skin care marks in the United States and the world. Hundreds of millions of dollars of Opposer's skin care products have been nationally sold in the United States under Opposer's NIVEA trademark. Many millions of dollars and considerable effort

have been expended in advertising, promoting, and publicizing Opposer's NIVEA trademark throughout the country.

4. By reason of the extensive use of Opposer's NIVEA trademark, and the excellence and superior quality of Opposer's NIVEA skin care products, an extremely valuable and inestimable good will has been built up in Opposer's NIVEA trademark.

5. Opposer's NIVEA trademark has been registered on the Principal Register in the United States Patent and Trademark Office. These registrations include:

- (a) No. 93,627 of Oct. 7, 1913 for cosmetic crème;
- (b) No. 809,393 of May 31, 1966 for cosmetic cream for the care of the skin;
- (c) No. 1,401,796 of Jul. 22, 1986 for moisturizing skin lotions.

Copies of these registrations are attached hereto as Exhibits A through C. All these registrations are subsisting, valid and incontestable. Opposer is the owner of said registrations, the trademarks shown therein and the good will of Opposer's business connected with and symbolized by said marks.

6. Upon information and belief, consumers have long been using Opposer's NIVEA skin care products to, inter alia,

reduce wrinkles and relieve the symptoms of various dermatologic disorders, including xerosis, eczema, psoriasis, and burns, and for soothing dry chapped skin.

7. The "human pharmaceuticals for the treatment of ... dermatologic disorders, ... wrinkles," and certain of the other "human pharmaceuticals" identified in the Opposed Applications, are related to Opposer's NIVEA skin care products.

8. Applicant's NUAVA trademark shown in Application Serial No. 85/495,821 so closely resembles Opposer's prior used and registered NIVEA trademark as to be likely, when applied to Applicant's Goods, to cause confusion, or to cause mistake, or to deceive.

9. Applicant's NUVEE trademark shown in Application Serial No. 85/495,815 so closely resembles Opposer's prior used and registered NIVEA trademark as to be likely, when applied to Applicant's Goods, to cause confusion, or to cause mistake, or to deceive.

10. Since long prior to the filing date of the Opposed Applications and continuing to the present, Opposer's distinctive

NIVEA trademark has been famous throughout the United States to the general public and healthcare professionals, including potential customers for Applicant's Goods.

11. Applicant's NUAVA trademark shown in Application Serial No. 85/495,821, when used for Applicant's Goods, is likely to cause dilution of the distinctive quality of Opposer's famous NIVEA trademark.

12. Applicant's NUVEE trademark shown in Application Serial No. 85/495,815, when used for Applicant's Goods, is likely to cause dilution of the distinctive quality of Opposer's famous NIVEA trademark.

13. From March 10, 2010 through December 15, 2011, Applicant filed in the U.S. Patent and Trademark Office more than 60 applications, for marks other than the Opposed Marks, all of which included (a) human pharmaceuticals for the treatment of "dermatologic disorders" and "wrinkles," and (b) the same or closely similar identifications of the other goods in the Opposed Applications. None of these applications, as filed, were based, in whole or in part, on use of the mark applied for, and none are so based now.

14. The "human pharmaceuticals" identified in the Opposed Applications are for the treatment of many widely diverse diseases, disorders and conditions.

15. On information and belief, at the time application Serial No. 85/495,821 was filed, Applicant had no bona fide intent to use, in the United States or in commerce with the United States, the mark NUAVA for the "human pharmaceuticals for the treatment of ... dermatologic disorders, ... wrinkles," identified in said application.

16. On information and belief, at the time application Serial No. 85/495,821 was filed, Applicant had no bona fide intent to use, in the United States or in commerce with the United States, the mark NUAVA for all the goods identified in said application.

17. On information and belief, at the time application Serial No. 85/495,815 was filed, Applicant had no bona fide intent to use, in the United States or in commerce with the United States, the mark NUVEE for the "human pharmaceuticals for the treatment of ... dermatologic disorders ... wrinkles," identified in said application.

18. On information and belief, at the time application Serial No. 85/495,815 was filed, Applicant had no bona fide intent to use, in the United States or in commerce with the United States, the mark NUVEE for all the goods identified in said application.

19. All the acts complained of herein by Opposer have occurred without its consent.

20. If Applicant were granted registration of the marks shown in the Opposed Applications, it would obtain the prima facie right to use said marks and all marks likely to be confused therewith, for the Applicant's Goods and all related goods and services. Each such registration would thus be a source of damage and injury to Opposer.

21. Opposer cannot control the quality of Applicant's Goods. The use of each of the marks shown in the Opposed Applications would, therefore, place in jeopardy the valuable reputation that Opposer has built up in its long prior, famous, and distinctive trademark NIVEA.

WHEREFORE, Opposer prays that each of said applications,
Serial Nos. 85/495,821 and 85/495,815, be refused and that this
Consolidated Opposition be sustained.

VON MALTITZ, DERENBERG, KUNIN,
JANSSEN & GIORDANO

By



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New York, NY 10165
Phone: 212-661-1400
Fax: 212-370-1819

Attorneys for Opposer

September 11, 2012

EXHIBIT A



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Nivea

Word Mark	NIVEA
Goods and Services	IC 003. US 051. G & S: [COSMETIC POWDER,] COSMETIC [PASTE] * CREME, * [AND PREPARATIONS FOR THE HAIR]. FIRST USE: 19050623. FIRST USE IN COMMERCE: 19050623
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	71069150
Filing Date	March 18, 1913
Current Basis	1A;44E
Original Filing Basis	1A;44E
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	0093627
Registration Date	October 7, 1913
Owner	(REGISTRANT) P. BEIERSDORF & CO. COMPOSED OF DR. OSCAR TROPLOWITZ AND OTTO HANNS MANKIEWICZ, SUBJECTS OF THE EMPORER OF GERMANY FIRM FED REP GERMANY EIDELSTEDTER WEG 38/44 HAMBURG FED REP GERMANY (LAST LISTED OWNER) BEIERSDORF AKTIENGESELLSCHAFT CORPORATION ASSIGNEE OF FED REP GERMANY UNNASTRASSE 48 D-2000 HAMBURG 20 FED REP GERMANY
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	THOMAS S BAKER, JR
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 12C. SECT 15. SECTION 8(10-YR) 20031126.
Renewal	5TH RENEWAL 20031126
Live/Dead Indicator	LIVE

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EXHIBIT B



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NIVEA

Word Mark	NIVEA
Goods and Services	IC 003. US 051. G & S: COSMETIC CREAM FOR THE CARE OF THE SKIN. FIRST USE: 19050623. FIRST USE IN COMMERCE: 19050623
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	72213538
Filing Date	March 8, 1965
Current Basis	1A
Original Filing Basis	1A
Registration Number	0809393
Registration Date	May 31, 1966
Owner	(REGISTRANT) DUKE LABORATORIES, INC. CORPORATION NEW YORK DUKE PLACE SOUTH NORWALK CONNECTICUT (LAST LISTED OWNER) BEIERSDORF AKTIENGESELLSCHAFT CORPORATION ASSIGNEE OF FED REP GERMANY UNNASTRASSE 48 20245 HAMBURG FED REP GERMANY
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	V.T. GIORDANO
Prior Registrations	0093627;0691036;AND OTHERS
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECTION 8(10-YR) 20060510.
Renewal	2ND RENEWAL 20060510
Live/Dead Indicator	LIVE

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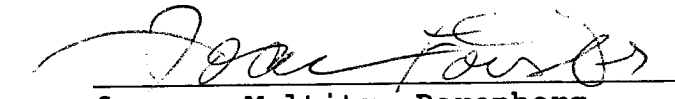
Typed Drawing

Word Mark	NIVEA
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: MOISTURIZING SKIN [AND SUN PROTECTION] LOTIONS. FIRST USE: 19740000. FIRST USE IN COMMERCE: 19740000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73574160
Filing Date	December 19, 1985
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 29, 1986
Registration Number	1401796
Registration Date	July 22, 1986
Owner	(REGISTRANT) BEIERSDORF AKTIENGESELLSCHAFT CORPORATION FED REP GERMANY UNNASTRASSE 48 20245 HAMBURG FED REP GERMANY
Attorney of Record	V. T. GIORDANO
Prior Registrations	0093627;0321882;0691036;0807893;0809393;1277742;1277746
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20060505.
Renewal	1ST RENEWAL 20060505
Live/Dead Indicator	LIVE

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CERTIFICATE OF SERVICE

A copy of the foregoing OPPOSER'S NOTICE OF OPPOSITION has been served by first class mail, by the undersigned, this 11th day of September, 2012, upon Applicant's attorney, Cheryl L. Foytlin, Johnson & Johnson, 1 Johnson and Johnson Plaza, New Brunswick, New Jersey 08933-0002


for von Maltitz, Derenberg,
Kunin, Janssen & Giordano

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Applications Serial Nos. 85/495,821 and
85/495,815

Both Published in the OFFICIAL GAZETTE on May 22, 2012

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BEIERSDORF AG,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
JOHNSON & JOHNSON,	:	
	:	
Applicant.	:	

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Notice of Consolidated Opposition by
BEIERSDORF AG
Against Applications Serial Nos. 85/495,821
and 85/495,815
Filed By JOHNSON & JOHNSON

"Express Mail" Mailing Label Number EL 910670818 US
Date of Deposit: September 11, 2012

I hereby certify that this Notice of Consolidated
Opposition, attached exhibits and fee are being deposited with
the United States Postal Service "Express Mail Post Office to
Addressee" service under 37 CFR 2.101 and 2.198 on the date
indicated above and is addressed to United States Patent and
Trademark Office, Trademark Trial and Appeal Board, P.O. Box
1451, Alexandria, VA 22313-1451.

